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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,449	03/26/2001	Scott Trece	P1577USA	9117

7590

06/17/2003

WOOD, PHILLIPS, KATZ, CLARK & MORTIMER  
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CHICAGO, IL 60661-2511

EXAMINER

MCCORMICK, SUSAN B

ART UNIT

PAPER NUMBER

1661

DATE MAILED: 06/17/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/817,449

**Applicant(s)**

TREES, SCOTT

**Examiner**

Susan B. McCormick

**Art Unit**

1661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 4-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3 is/are allowed.
- 6) ☒ Claim(s) 4-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### **Detailed Action**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 24, 2003 has been entered.

### **35 U.S.C. 112**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

### **Written Description**

Claims 4, 6-10, 11, 13-17 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In analyzing whether the written description requirement is met for genus claims, it is determined whether a representative number of species have been described. In this case, the one disclosed embodiment is not representative of the enormous number of products claimed. Lobelias can vary widely in flower morphology, flower color, leaf morphology, pest resistance and many other characteristics. Since these traits vary independently, the claims encompass millions of plants having unique combinations of phenotypic characteristics. The specification only provides a complete description of 'BFP-100'. Therefore, Applicants are not in possession of the claimed genus.

### **Enablement**

Claims 5-10 and 12 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The skilled artisan would not know how to make the claimed plants because the specification does not teach a reproducible method of making BFP-100 because, due to the random nature of gene segregation during sexual

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reproduction, the odds against reproducing BFP-100 from the disclosed starting materials are astronomical.

Applicant wishes to hold a deposit of seed in abeyance. To clarify the Office's position, the Office did not require a deposit of **seed** (emphasis added) because it does not appear that BFP-100 is a plant line which breeds true from seed. If there is a written assurance that an acceptable deposit will be made the claims can be allowed (see MPEP 2411-03), but Applicant has not indicated what they intend to deposit, so the Office cannot tell if it is "acceptable."

#### Response to Arguments

Applicant reiterates the MPEP Section 2163 for the Examiner, however there is no argument to point out.

Applicant argues (page 4, paragraph 2 of response) that the specification filed is adequate and reasonably conveys to one skilled in the relevant art that the inventors, at the time the application was filed had possession of the claimed invention. This is not persuasive as discussed in the above arguments due to the random nature of gene segregation during **sexual reproduction** (emphasis added) the odds of making BFP-100 exactly identical are colossal. Therefore, Applicant does not have possession of the claimed invention. Using elementary Mendelian genetics anyone using the two parents of the claimed BFP-100, *Lobelia erinus* and *Lobelia valida*, would know the enormous statistical variances that could be attempted to be able to make the claimed invention.

Applicant wishes to hold making a deposit in abeyance until a notification of allowance is set forth. Again (papers no. 5 and 11 and in above response) to clarify the Office's position, the Office did not require a deposit of **seed** (emphasis added) because it does not appear that BFP-100 is a plant line which breeds true from seed. Given written assurance that an acceptable deposit will be made the enablement rejection will be withdrawn but Applicant has not indicated what they intend to deposit, so the Office cannot tell if it is "acceptable."

#### Amendments in a Revised Format Now Permitted

The USPTO is permitting applicants to submit amendments in a revised format. The revised amendment format is essentially the same as the amendment format that the Office is considering adopting via a revision to 37 CFR 1.121. Compliance to the revision to 37 CFR 1.121 (if adopted) will be

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mandatory by July of 2003. Complete details to the revised amendment format can be found on the Internet at <http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/revamdtprac.htm>.

#### Conclusion

Claims 1-3 are allowed.

This is a request for continued examination of Applicant's earlier Application No. 09/817,449. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

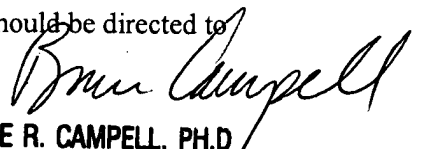
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

#### Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Susan B. McCormick whose telephone number is (703) 305-1682. The Examiner can normally be reached Monday through Thursday from 6:00 a.m. to 4:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached on (703) 308-4205. The fax number for the group is (703) 305-3014 or 308-4242. Additional fax numbers are "before final" (703) 872-9306, "after final" (703) 872-9307 and for customer service is (703) 872-9305.

Any inquiry of a general nature or relating to the status of this application should be directed to the Matrix Customer Service Center whose telephone number is (703) 308-0196.

  
**BRUCE R. CAMPPELL, PH.D.**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 1600**